

REMARKS

The Applicant has carefully reviewed the Office Action dated September 16, 2005 and notes with appreciation the Examiner's comments. First, addressing the formal issues, it is believed that the rejections of claims 4, 5 and 9 are mooted or overcome by the amendments presented. Claim 4 is canceled without prejudice, and the Applicant reserves the right to represent the claim in a continuation patent application. The objection raised is therefore rendered moot. The amendments to claims 5 and 9 are believed to appropriately address the antecedent basis objection raised by the Examiner. Withdrawal of the rejection of those claims under 35 U.S.C. §112, 2d paragraph, is respectfully requested.

Claims 1-3, 6-8 and 10-15 stand rejected under 35 U.S.C. §103(a) as allegedly "obvious" based on the combination of Hord et al. (U.S. Patent Application No. 10/223,171) and Hosaka (U.S. Patent Application No. 10/723,584). It is well settled that the propriety of any rejection based upon 35 U.S.C. §103 rests upon whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."¹ The Manual of Patent Examining Procedure § 2143.03 aptly states that "[t]o establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art", and that "all words in a claim must be considered in judging the patentability of that claim against

¹ *Graham v. John Deere Co.*, 383 U.S. 1, 13; 48 USPQ 459, 465 (1966).

the prior art.”² In view of this precedent, the Applicant submits that the *prima facie* case of obviousness under Section 103 is negated, and respectfully requests reconsideration.

The Applicant first notes that the Hosaka reference was filed on November 26, 2003, and accordingly can be used as Section 103 prior art no earlier than that date. In contrast, as reflected on the filing receipt, the present application properly claims priority to U.S. Provisional Patent Application S.N. 60/518,174, filed on November 7, 2003. On these grounds, the Applicant does not believe that the Hosaka reference can properly be asserted against any claims of the present application due to its later effective date.

With the Hosaka reference removed from consideration, any finding of obviousness now rests on the Hord reference, and the Examiner’s unsupported statement that “it would have been obvious that a display system includes image projection means.” Respectfully, as to the Examiner’s statement regarding “image projection means,” without some evidentiary support this bare assertion simply cannot properly serve as a foundation for a finding of obviousness. Accordingly, the rejection appears to rest solely on Hord. The Examiner has rightly made of record that Hord provides no teaching of “image projection means,” and similarly no suggestion or motivation for this feature is found within the four corners of Hord. The Section 103 rejection is believed to be improper, since all of the claim limitations are not found in the Hord et al. reference.

² *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970); Manual of Patent Examining Procedure §2143.03.

It is believed that no amendment to the claims is necessary to overcome the references cited by the Examiner. Nevertheless, in an effort to expedite prosecution of this patent application rather than to overcome any argument of unpatentability, the Applicant presents amended claims 1, 13, and 14, including the feature of projecting a light source on a surface at a frequency of 60 to 120 beats per minute. As noted above, the Examiner has rightly made of record that the Hord et al. published patent application provides no teaching of projecting a light source on a surface. Even further, it is believed that Hord provides no teaching, suggestion, or motivation for a method or apparatus for providing a marketing display, comprising projecting a pattern on a surface intermittently at a frequency of 60 to 120 beats per minute. Absent this teaching, suggestion, or motivation, the Hord reference provides no basis for rejection of any of the amended claims.

Finally, the Applicant has considered the additional art cited by the Examiner, and agrees that it provides no basis for any claims rejections.

Summarizing, the Applicant believes that the independent claims of this application are in condition for allowance. The claims properly depending from those claims are therefore also believed to be in condition for allowance under the teachings of *In re Fine*.³ A notice to this effect is therefore earnestly solicited. In the event that some additional point

³ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

requires attention, please telephone the Applicant's attorney to expedite issuance of the patent. In the event any fee is due, please debit it from Deposit Account 11-0978.

Respectfully submitted,

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